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09/501,169	02/09/2000	William T. Carden Jr.	35672-164254	3485

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EXAMINER

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/501,169

Applicant(s)

CARDEN JR., WILLIAM T.

Examiner

Nathan Hillery

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication:
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 10/24/03.
2. **This action is made Final.**
3. The objections to the drawings have been withdrawn as necessitated by amendment.
4. The rejection of claims 23 and 24 under 35 U.S.C. 112, second paragraph as being incomplete has been withdrawn as necessitated by amendment.
5. The rejection of claims 17 – 24 under 35 U.S.C. 112, second paragraph as being incomplete has been withdrawn as necessitated by amendment.
6. The rejection of claim 12 under 35 U.S.C. 112, second paragraph as being indefinite has been withdrawn as necessitated by amendment.
7. The rejection of claims 13 – 15, 17 and 18 under 35 U.S.C. 103(a) as being unpatentable over Myers et al. and Alam et al. has been withdrawn as necessitated by amendment.
8. The rejection of claims 16, 19, and 23 under 35 U.S.C. 103(a) as being unpatentable over Myers et al., Alam et al., and Ivanov (US005706452A) has been withdrawn as necessitated by amendment.
9. The rejection of claims 20 – 22 and 24 under 35 U.S.C. 103(a) as being unpatentable over Myers et al., Alam et al., and DeLorme et al. has been withdrawn as necessitated by amendment.
10. The rejection of claims 1 – 5 and 8 - 12 under 35 U.S.C. 102(e) as being anticipated by Myers et al. has been maintained.

11. The rejection of claims 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Myers et al. and Alam et al. has been maintained.

12. Claims 1 – 24 are pending in the case. Claims 1, 13, and 17 are independent.

Claim Rejections - 35 USC § 102

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 1 – 5 and 8 - 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Myers et al. (US006374274B1).

15. **Regarding independent claim 1**, Myers et al. discloses a “publishing system ...” comprising a “database ...”, a “plurality of computers ...”, and a “network ...” or a *network database system wherein clients of subscribing entities are authorized network access to reliable documents* (see Abstract and Fig. 1). Myers et al. teaches said system also comprising a “submitting means ...”, a “reviewing means ...”, a “relating means ...”, and a “publishing means ...” that performs. Read Col. 3, lines 4 and 5; Col. 7, lines 23 – 43; Col. 4, lines 2 – 5; Col. 1, lines 18 – 33, Col 4, lines 54 – 57; respectively, in which Myers et al. discloses *receiving and processing data from a provider*, which is the same as “submitting a new document”. Myers et al. also discloses that *anything that is stored in the practitioner/client database(s) can be displayed on the document pages* (Col. 7, lines 41 – 42), which is the same as the “reviewing means ...”. Further disclosed is a *plurality of document files* in which *map files define links to related documents* (Col. 4, lines 2 – 5), which is the same as having a “relating means”. Myers et al. also discloses a “publishing means ...” in Col. 1, lines 18 – 22; *one application of*

information retrieval systems is to provide (by display, printing, or other appropriate means) a collection of documents that is directed to a particular field, so that a particular set of authorized users can select and retrieve a desired portion of the collection.

16. **Regarding dependent claims 2 and 3**, Myers et al. teaches a system as stated above that has a “web server ...” and “plurality of clients ...” each having a “browser ...”. (see Figure 1; read Col. 6, lines 35 – 40).

17. **Regarding dependent claim 8**, Myers et al. teaches a system described above that has a “server ...” with “searching means ...” or *a suitable primary server can be implemented with the server computer running MICROSOFT SQL SERVER 6.5* (Col. 3, lines 53 – 68). (read also Col.6, lines 48 – 51).

18. **Regarding dependent claims 4, 5, and 9**, Myers et al. teaches a system as described above that has a “submitting means ...” that comprises “translating” from a “native word processor format” to a “format compatible” to a “browser” specifically a “hypertext mark-up language (HTML) format”. (read Columns 4 - 5).

19. **Regarding dependent claims 10 - 12**, Myers et al. teaches a system as previously described “comprising a removable medium” that stores the “database”, has a “searching means”, and has a “communicating means” with the “server”. (read Col. 3, lines 43 – 53). Claim 10 specifically incorporates similar subject matter as claim 8 and is partially rejected along that rationale. Further, according to the Tiscali Reference <http://www.tiscali.co.uk/reference/dictionaries/computers/data/m0045454.html>, “browser” is defined as *any program that allows the user to search for and view data.*

Thus, the program used for “communicating” between the “removable medium” and “server” is a “browser”.

Claim Rejections - 35 USC § 103

20. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

21. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (US006374274B1) as applied to claims 1 – 5 above, and further in view of Alam et al. (US006336124B1).

22. **Regarding dependent claims 6 and 7**, Myers et al. fails to teach “translating means” from HTML, “second data format”, to “a third data format” specifically “a conventional typesetting format” or “conventional page layout format”. However, Alam et al. does teach *a computer implemented method of converting a document in an input format to a document in a different output format* (see Abstract). For more details see Col. 23, lines 30-39. Alam et al also explains a “conventional page layout format” as disclosed in Col. 25, lines 25 – 56. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Alam et al. with Myers et al. because such a combination would give added flexibility to subscribers, thereby allowing them to publish articles in other formats for their authorized network clients.

23. Claims 13 – 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (US006374274B1) and Alam et al. (US006336124B1) and further in view of Ivanov (US005706452A).

24. **Regarding independent claim 13**, the claim incorporates substantially similar subject matter as claims 1 – 7, and is rejected along the same rationale. Further, regarding the limitation of **inputting a new document to said computer system from another location displaced remotely from said one location, said new document having been input from at least one of said plurality of clients**, Ivanov teaches that *Fig 1 is a ... system that connects a number of personal computers [Fig 1.22] and a number of server computers [Fig 1.24], allowing them to communicate. A user seated in front of personal computer [Fig 1.22] can create, access, modify, and delete data, which is shared with other users and resides on server computer [Fig 1.24]* (Column 7, lines 23 – 29). It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ivanov with Alam et al. and Myers et al. because such a combination would *allow one to define efficient document evaluation strategies that take advantage of the inherent parallelism within a business process.* (Abstract)
25. **Regarding independent claim 17**, the claim incorporates substantially similar subject matter as claim 13, and is rejected along the same rationale.
26. **Regarding dependent claims 14, 15 and 18**, the claims incorporate substantially similar subject matter as claims 1 – 7, and are rejected along the same rationale.
27. **Regarding dependent claim 16**, neither Myers et al. or Alam et al. teach “assigning a reviewer to review said document ...” and “notifying said reviewer through said network that said new document is available for review”. However, Ivanov discloses that the *workflow manager* of Fig. 2 uses *global variables in order to assign*

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reviewers from a pool. (Col. 33, lines 11 – 18) Ivanov also teaches that *documents to be reviewed are prepared by a set of preparers, and are stored into a database and a set of reviewers is notified that the document is ready for their review ... via electronic mail.* (Abstract) Ivanov discloses the network used to notify reviewers in Col. 7, lines 23 – 67 and Col. 8, lines 1 – 8. Ivanov also discloses that the invention *allows concurrent access to shared data from a multitude of locations.* (Col.5, lines 19 – 20) It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ivanov with Alam et al. and Myers et al. because such a combination would *allow one to define efficient document evaluation strategies that take advantage of the inherent parallelism within a business process.* (Abstract) Col 1, lines 60 – 67 provide further motivation.

28. **Regarding dependent claim 19**, it would have been obvious to one skilled in the art to have the journal “published in advance” for a peer review session.

29. **Regarding dependent claim 23**, Myers et al. teaches a system that has a “server ...” with “searching means ...” or *a suitable primary server can be implemented with the server computer running MICROSOFT SQL SERVER 6.5* (Col 3, lines 53 - 68).

30. Claims 20 – 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. (US006374274B1) and Alam et al. (US006336124B1) as applied to claim 17 above, and further in view of DeLorme et al. (US005948040A).

31. **Regarding dependent claims 20 – 22 and 24**, Alam et al. and Myers et al. fail to teach ways “to facilitate access ...”, “for making reservations ...”, “for registering ...”, “for reserving one or more breaks ... a room ... transportation ...”, or “planning an

itinerary ...". However, DeLorme et al. discloses a *computerized travel reservation information and planning system* that provides searches of events calendars, almanacs, appointment books, related itinerary scheduling ... This system also provides users to engage in an iterative planning process, revising or editing travel plans, previewing travel logs of alternative routes, and comparing times and costs of transportation options. (Abstract) Further, a myriad of features would be possible add-ons to *Travel Reservation and Information Planning Systems* as disclosed in Col. 1, lines 32 – 37. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine DeLorme et al. with Alam et al. and Myers et al. because such a combination would allow the remote clients to interface more personally with the providers and editors within the organization.

Response to Arguments

32. Applicant's arguments filed 10/24/03 have been fully considered but they are not persuasive.

33. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., author permissions, copyright transfer acknowledgements, other author acknowledgements, and online payments by the authors) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

34. **Regarding independent claim 1**, the Applicant states that, “Myers neither teaches nor suggests a network connecting said plurality of computers together for communication of data relating to said plurality of documents among said plurality of computers and said database ...” (page 16, last sentence, last paragraph). The Applicant is directed towards the rejection of claim 1 as restated above; specifically, Myers et al. discloses ... *a network database system wherein clients of subscribing entities are authorized network access to reliable documents* (see Abstract and Fig. 1). In additional support, it is further noted that Myers et al. explains that *With reference to FIGS. 1 – 6 of the drawings, a network database system [Fig. 1.10] ... connectable to a distributed computer network* (Column 3, lines 2 – 7).

35. **Regarding independent claim 1**, the Applicant further states that, “[Myers neither teaches nor suggests] a means for publishing a journal of a selected portion of said plurality of documents” (page 16, last sentence, last paragraph) and that “Myers neither teaches nor suggests the preparing of a journal as claimed and to which users have access ...” (page 17, lines 3 – 5). The Applicant is directed towards the rejection of claim 1 as restated above; specifically, Myers et al. also discloses ... *one application of information retrieval systems is to provide (by display, printing, or other appropriate means) a collection of documents that is directed to a particular field, so that a particular set of authorized users can select and retrieve a desired portion of the collection* (Column 1, lines 18 – 22). In additional support, it is further noted that the Encarta® World English Dictionary, North American Edition defines “journal” as *[In] PUBLISHING magazine or periodical: a magazine or periodical, especially one published by a*

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specialist or professional body for its members, containing information and contributions relevant to their area of activity [i.e.] a medical journal; therefore, the skilled artisan is cognizant of the fact that practitioner subscribed educational materials are a form of a journal reflecting articles or medical information pertinent or relevant to patient care and health.

36. **Regarding independent claim 1**, the Applicant states that, “Myers neither teaches nor suggests a network of computers reviewing and altering documents where the updated documents are provided to databases for continued interaction and/or review and revision. See claim 1, elements 4 – 6” (page 17, lines 1 – 3). The Applicant is directed towards the rejection of claim in which elements 4 – 6 are addressed above; specifically, Myers et al. discloses *receiving and processing data from a provider* (Col. 3, lines 4 – 5), which is the same as “submitting a new document”. Myers et al. also discloses that *anything that is stored in the practitioner/client database(s) can be displayed on the document pages* (Col. 7, lines 41 – 42), which is the same as the “reviewing means ...”. Further disclosed is a *plurality of document files in which map files define links to related documents* (Col. 4, lines 2 – 5), which is the same as having a “relating means”. In additional support, it is further noted that Myers et al. explains that *once registered, patients have access from the default page and a client login window to the subscriber’s home page and the index page* (Col. 7, lines 23 – 25). It is noted that this section was cited for reading in the previous office action (page 5, lines 3 – 4).

37. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., peer review of content, grading of content, decision making, and scheduling of conference sessions at which the content will be presented) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

38. In response to applicant's argument that "Alam cannot be incorporated into Myers because their teachings conflict" (page 19, last paragraph, line 2), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

39. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

40. Applicant's arguments with respect to claims 13 – ²⁴~~40~~ have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

41. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


JOSEPH H. FEILD
PRIMARY EXAMINER

NH